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|---|---|
| BOYCE, ANDRE D | |

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Paper No. 25

Application Number: 09/093,958
Filing Date: June 08, 1998
Appellant(s): KEITH ET AL.



Bradley K. DeSandro
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 14, 2003.

***(1) Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

***(2) Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

***(3) Status of Claims***

The statement of the status of the claims contained in the brief is correct.

***(4) Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

***(5) Summary of Invention***

The summary of invention contained in the brief is correct.

***(6) Issues***

The appellant's statement of the issues in the brief is correct.

***(7) Grouping of Claims***

Appellant's brief includes a statement that claims 1-4, 20-23, and 36-42 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Group I includes claims 1-4 and 36.

Group II includes claims 20-23 and 37-42.

***(8) Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

***(9) Prior Art of Record***

| | | |
|---|---|---|
| 6,219,669 | HAFF et al | 4-2001 |
| 5,963,925 | KOLLING et al | 10-1999 |

***(10) Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Haff et al (USPN 6,219,669).

Claims 20-23, and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haff et al (USPN 6,219,669), in view of Kolling et al (USPN 5,963,925).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Haff et al, U.S. Patent No. 6,219,669.

| Claim 1 | Prior Art |
|---|---|
| A parcel manager for managing the transfer of data from a local computer to a remote computer, the parcel manager being embodied on a computer readable medium, comprising | main control module (see Fig 2)<br>file transfer system (col. 21, lines 29-35) |
| 1) an interface object to present an interface into the parcel manager from one or more external applications, | communication interface (col. 21, lines 18-22) |
| 2) a parcel object created via a first function presented by the interface object, the parcel object providing functionality to place the data in one or more parcel components for transferring to the remote computer, each parcel component being particularized to contain and carry a particular type of data that was requested, and | control module (col. 22, lines 40-45)<br>graphical object (col. 22, lines 10-16)<br>file packet (col. 22, lines 34-37)<br>file index by file type (col. 7, lines 62-65)<br>(col. 38, lines 1-11) |

Claim 1 continued

3) a notification object created via a second function presented by the interface object in response to a request from an external application, the notification object providing functionality to track a status of the parcel object as the parcel components are transferred to the remote computer.

Prior Art continued

control module visibly indicates when packet has been received (col. 22, lines 62-67)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 20-23, and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haff et al, in view of Kolling et al, U.S. Patent No. 5,963,925.

Claim 20

Haff et al does not disclose the particular type of data is batch statement data. Kolling et al disclose electronic batch statement data sent by a biller (see column 9, lines 40-48). Both Haff et al and Kolling et al are concerned with the efficient transfer of data, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include batch statement data in the Haff et al system, as seen in the Kolling et al system, thereby being able to effectively communicate the cost of services rendered (see Haff et al, column 1, lines 51-

55), thus making the system more flexible in dealing with various business models (see Haff, column 47, lines 5-6).

***(11) Response to Argument***

In the Appeal Brief, Appellant argues 1) there is a distinction between data and file, 2) that Haff et al does not teach that the user must select only certain files, that file selection limited to only those files that contain a particular type of data, that the user must investigate what type of files are valid, based on one or more types of data they respectively contain, before the user makes a selection from among the displayed files, or a file having different data types therein from which the user selects one of those data types for copying and transmission, 3) that Haff et al does not teach that a file packet is to contain only a particular type of data, but rather is to contain only the contents of those files the user selects, 4) that Haff et al does not teach a "parcel component being particularized to contain and carry a particular type of data", 5) that the Final rejection did not reject claims 1-4 and 36 as being obvious over Haff et al or Haff et al, in view of Kolling et al, and 6) that the Final rejection has not made out a prima facie case of obviousness of claims 20-23 and 37-42 under 35 USC § 103(a) over Haff et al, in view of Kolling et al.

In response to argument 1, Appellant defines a file as "a collection of data or information that has a name". Appellant goes on to define a program, and asserts that "a data file is fundamentally different from a program file." Appellant then concludes "the term data is fundamentally different than the term file." The Examiner respectfully disagrees with Appellant's conclusion, and submits that a file is further defined as "the basic unit of storage that enables a

computer to distinguish one set of information from another", and that data is defined as "plural of the Latin datum, meaning an item of information" (Microsoft Press, Computer Dictionary 3rd Edition, 1997). As seen in the above definitions, data represented on a computer must be represented by a file, even if it's a temporary file. Therefore, data and file are not fundamentally different, but inherently linked. Further, even if data and file were distinguishable, Haff et al explicitly teaches data and file transfer, as seen throughout the specification (see column 8, lines 17-21, column 10, lines 27-29, and column 11, lines 65-67 as some examples).

In response to argument 2, the Examiner respectfully submits that the features upon which Appellant relies, including that the user must select only certain files, that file selection limited to only those files that contain a particular type of data, that the user must investigate what type of files are valid, based on one or more types of data they respectively contain, before the user makes a selection from among the displayed files, and a file having different data types therein from which the user selects one of those data types for copying and transmission, are not recited in the rejected claims, and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to argument 3, the Examiner respectfully disagrees with Appellant's assertions, and submits that Haff et al discloses creation of a file index. As disclosed by Haff et al, criteria can be invoked in creating a file index, including location in file structure, **file type**, file date & time, embedded serial number, and destination authentication codes (see column 7, lines 62-65). By creating an index, the user is able to select files that belong to a specific directory tree, files created at a specific time and date, and/or **files by specific extension** (i.e.,

file/data type, see column 38, lines 1-11). Therefore, the **file packet** disclosed by Haff et al (see column 22, lines 34-37) indeed contains a particular type of data, as determined via the **file index**.

In response to argument 4, the Examiner respectfully disagrees with Appellant's assertion and reiterates the response as seen above with respect to argument 2. Through creation of an index, Haff et al indeed discloses a parcel component (i.e., file index transferred via file packet, see column 22, lines 34-37) being particularized to contain and carry a particular type of data (i.e., file/data type as chosen by the user, see column 7, lines 62-65 and column 38, lines 1-11).

In response to argument 5, the Examiner respectfully submits that, as seen in the Final rejection, claims 1-4 and 36 remain rejected under 35 USC § 102 (e) as being anticipated by Haff et al, and are therefore obvious over Haff et al.

In response to argument 6, the Examiner respectfully submits that, as seen in the Final rejection, claims 20-23 and 37-42 remain rejected under 35 USC § 103(a) as being unpatentable over Haff et al, in view of Kolling et al. Therefore, the prima facie case of obvious has indeed been made.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Andre Boyce

adb
July 13, 2003

Conferees

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